

- Group I: Claims 1-27, drawn to isolated DNA molecules encoding an MEKK interacting protein FHA (MIF1), vectors and host cells comprising said molecules, oligonucleotides of said molecules of at least 10 bases in length, isolated FHA proteins and fragments thereof;
- Group II: Claims 28-30 and 32, drawn to antibodies which bind said MIF1 proteins and methods of using said antibodies;
- Group III: Claim 31, drawn to hybridization assays using said DNA molecules;
- Group IV: Claims 33-38, drawn to methods of screening for modulators of MIF1 polypeptides; and
- Group V: Claims 39-44, drawn to methods of decreasing or increasing the MEKK activity using MIF1 protein.

In the action, the Examiner has admitted that the Claims of Group I and III share a special technical feature, but that these Claims are not required to be rejoined under PCT Rule 13.1 because, in the Examiner's opinion, the Claims of Group I already have a method of using the claimed DNA. In addition, the Examiner has asserted that the Claims of Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, in the Examiner's opinion, under PCT Rule 13.2, they lack the same or corresponding special technical features. In particular, the Examiner believes that the special technical features of the Claims of Groups I, II, IV and V are DNA, antibodies, modulators and MIF1 proteins, respectively, which the Examiner believes possess unrelated chemical and structural functions.

In response, solely to be responsive to the requirement for restriction, Applicants provisionally elect, WITH TRAVERSAL, to prosecute the invention of Group I, Claims 1-27, drawn to isolated DNA molecules encoding an MEKK interacting protein FHA (MIF1), vectors and host cells comprising said molecules, oligonucleotides of said molecules of at least 10 bases in length, isolated FHA proteins and fragments thereof. Furthermore, Applicants respectfully request reconsideration of the requirement for restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of claims designated by the Examiner in the present application, for reasons provided as follows:

Under 35 U.S.C. § 121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the Examiner has failed to define compositions and methods for using such compositions with properties so distinct as to warrant separate examination and search. In particular, the Examiner has failed to note separate classifications for each group of Claims. Consequently, other than the Examiner's opinions, no evidence has been provided that each of these Groups of Claims falls into a separate classification.

Moreover, contrary to the Examiner's assertions, these groups of Claims are related. For example, the Claims of Group II, which are drawn to antibodies, utilize an MIF1 protein of the Claims of Group I; the Claim of Group III, which is drawn to a hybridization assay, uses DNA molecules of the Claims of Group I; the Claims of Group IV, which are drawn to methods of screening for modulators of MIF1 polypeptides, utilize an MIF1 protein of Claims of the Group I; and the Claims of Group V, which are drawn to methods of decreasing or increasing the MEKK activity, utilize an MIF1 protein of the Claims of Group I. Consequently, these Groups of Claims are related.

In addition, it is respectfully submitted that PCT rule 13.1 does not state that the Claims of Groups I and III are not required to be rejoined. PCT Rule 13.1 states that 'The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").' However, the Examiner has admitted that the Claims of Groups I and III share a special technical feature.

In light of the above, Applicants respectfully submit that the search and examination of the entire Application, or, at least, of Group I together with Group III, can be made without a serious burden to the Examiner. Hence, the Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit the conjoint examination and inclusion of all the

Claims of the present Application would not present an undue burden on the Examiner.

Accordingly, withdrawal of the Requirement for Restriction, or, at least, modification to include the Claims of Group I, along with the Claims of Group III, is respectfully requested.

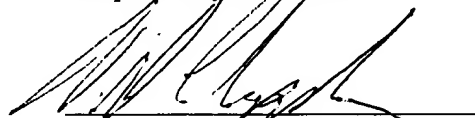
Fees

No additional fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 18-1982 for any underpayment, or credit any overages.

CONCLUSION

In view of the above, early action on the merits is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William C. Coppola', is written over a horizontal line.

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